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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,620	05/08/2007	Jakob Maier Jun	4100.P0423US	9965

23474 7590 03/02/2010  
FLYNN THIEL BOUTELL & TANIS, P.C.  
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KALAMAZOO, MI 49008-1631

EXAMINER
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HAYES, KRISTEN C

ART UNIT	PAPER NUMBER
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3643

MAIL DATE	DELIVERY MODE
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03/02/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,620	<b>Applicant(s)</b> MAIER JUN ET AL.	
	<b>Examiner</b> KRISTEN C. HAYES	<b>Art Unit</b> 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 56 and 58-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56 and 58-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/19/2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

### ***Specification***

2. The substitute specification filed 05/19/2009 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: A substitute specification submitted under this section must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 56 is rejected under 35 U.S.C. 102(b) as being anticipated by Goldberg et al. US 4,610,220 (hereinafter *Goldberg*).

5. Regarding claim 56, Goldberg discloses a teat rubber (Goldberg, Figures 4, 5) comprising a head part (14', 114) having a sealing lip (30', 156) that forms an insertion opening, a holding edge (122) (Goldberg, Figure 4), a milking cup sleeve (15), a suction connecting piece (near 34', near 168) connected to the head part as well as a planar teat bearing section (50, 144) which is formed on the sealing lip, a part of the insertion opening conically tapering (near 30', near 156)(Goldberg, Figures 4, 5) towards the inner side of the teat rubber in such a way that the inner annular fold (as best understood) located on the base of the teat cannot come into contact with the teat rubber and that pressure cannot be applied thereto; characterized in that when seen in a cross sectional view, a conically tapering surface (near 52, near 146) of the conically tapering insertion opening is convex and that a transition between the conically tapering surface and the planar teat bearing section and the udder bearing surface (at 52, at 142, 146) is implemented in a hingelike manner (Goldberg, column 4: lines 33-35, column 6: lines 29-32) (indentations at 30', 52, 156, 154), and the hingelike transitions comprise a portion of reduced material thickness (Goldberg, column 4: lines 33-35, column 6: lines 29-32) and an indentation (30', 52, 156, 154).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 58-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. US 4,610,220 in view of Silver et al. US 2002/0198489 (hereinafter *Silver*).

8. Regarding claim 58, Goldberg discloses the device of claim 56 but does not disclose a cushion portion of the teat bearing section. Silver teaches an entire teat receiving portion having cushioned surfaces associated with the planar teat bearing sections (735, 740) (Silver, ¶0160). It would have been obvious to one of ordinary skill in the art at the time of the invention to cushion the entire planar teat bearing section of Goldberg, in view of Silver, so as to predictably increase the comfort of the device for the animal.

9. Regarding claims 59, 60 and 62, Goldberg in view of Silver discloses the device of claim 43 and further discloses an entire teat bearing portion cushioned surface consisting of foam (Silver, ¶0160). Not disclosed is the foam being a foamed silicone elastomer. However, foamed silicone elastomer is well known in the art. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the foam a foamed silicone elastomer as to maintain the flexibility of the teat rubber while providing cushion.

10. Regarding claim 61, Goldberg in view of Silver discloses a foamed elastomer. The limitation of the foamed elastomer being sprayed to form the cushioned surface is considered a product-by-process limitation. It has been held that even though product-by-process claims are

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limited by and defined by the process, determination of patentability is based on the product itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966.

11. Regarding claim 63, Goldberg in view of Silver further discloses the cushioned surfaces being cushioned pockets (Silver, 742, 738, 740).

12. Regarding claim 64, Goldberg in view of Silver further discloses the cushioned surface being a fluid-filled pad (Silver, 740).

13. Regarding claims 65 and 66, Goldberg in view of Silver further discloses the fluid-filled pad being a replaceable insert (Silver, 340) (In that the fluid-filled pad is a separate element. The area in which the pad is positioned is openable, as the wall elements rest on each other and are therefore not permanently connected (Silver, ¶0159: lines 7-9)).

### ***Response to Arguments***

14. Applicant's arguments filed 05/19/2009 have been fully considered but they are not persuasive.

15. The material thickness difference of Goldberg is seen as forming a hinge, as per applicant's invention. Also, the indentation of Goldberg is considered to form a hinge.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. HAYES whose telephone number is (571)270-3093. The examiner can normally be reached on Monday-Thursday, 7:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571)272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCH  
25 February 2010

/Rob Swiatek/  
Primary Examiner, Art Unit 3643  
25 February 2010